

REMARKS

This Amendment is submitted in response to the non-final Office action of April 7, 2006 ("Office Action"), in the above-referenced patent application. As discussed during the June 29 interview the claims after this amendment should be in an allowable state, and allowance thereof is respectfully requested.

STATUS OF THE CLAIMS

Claims 21-34 are currently pending in the application. Claims 21-23, 27-30 and 34 stand rejected under 35 U.S.C. § 103(a) over Wallman (U.S. Pat. No. 6,601,044) ("Wallman")¹. Independent claims 21 and 28 have been amended. No new matter is added by these amendments. As reviewed during the June 29 interview support for "search results indicat[ing] the level the search results match the weighted criteria" is found at least at: Page 13 lines 8-14; Page 12, lines 5-10; Page 8, lines 16 - Page 9, line 7; Figures 2d, 2e, 2j, item 122, 2k, 2n, 2o, 2q, 2r, 2u, 2v and 2w.

Also as reviewed during the June 29 interview, support for "the search interface operative to perform subsequent searches within stored results of a prior search to limit search results when existing search criteria values are revised; the search interface operative to perform other subsequent searches to interrogate at least one network-enabled information source to expand search results when criteria are added; and the search interface operative to recalculate and represent the result indicators which indicate the level the search results match the weighted criteria" is found at least at: Page 10, line 14 - Page 11, line 6; Figures 2k, 2l, 2w, 3 item 316.

¹ The rejection is under a § 103(a) heading and form paragraph, but § 102(e) is subsequently cited as the rejection reason. Since the body of the rejection is directed to a § 103(a) rejection, it is being addressed as such. It was confirmed during the June 29 interview that the intended rejection was under § 103, not § 102.

In sum, the support for the amendment to both independent claims 21 and 28 was confirmed during the June 29 interview.

INDEPENDENT CLAIMS 21 AND 28

Independent Claims 21 and 28 currently stand rejected as obvious over Wallman. This rejection is hereby respectfully traversed.

The Examiner admits that "Wallman does not explicitly disclose a first set of investment funds that do not satisfy all of the user-selected quantitative search criteria, but which satisfy the overall user-defined criteria based on the combination of the user-selected weighting criteria and the user-selected quantitative criteria." See, e.g., April 7, 2006 Office Action, Page 3. The Examiner alleges, however, that certain aspects of the claimed invention would be obvious because of Wallman. See April 7, 2006 Office Action, Page 4, lines 1-9 As noted above for the prosecution record, Applicants respectfully disagree that there is a suggestion or motivation to modify the Wallman reference as urged.

Nevertheless, in order to advance prosecution of this application in accordance with the discussions during the June 29 interview, Applicant is making amendment to the pending independent claims in order to moot the issue. Thus, as discussed during the June 29 interview, the Wallman reference clearly does not disclose or suggest the current amendments to independent claims 21 and 28. As discussed during the interview Wallman does not disclose or suggest the amendments to independent claim 21 to include:

wherein the search results indicate the level the search results match the weighted criteria; the search interface operative to perform subsequent searches within stored results of a prior search to limit search results when existing search criteria values are revised; the search interface operative to perform other subsequent searches to interrogate at least one network-enabled information source to expand search results when criteria are added; and the search interface operative to recalculate and

represent the result indicators which indicate the level the search results match the weighted criteria.

Similarly, Wallman does not disclose the similar limitations in the amendment to independent claim 28 including:

wherein the search results indicate the level the search results match the weighted criteria; performing subsequent searches comprising: searching within stored results of a prior search to limit search results when existing search criteria values are revised; interrogating at least one network-enabled information source to expand search results when criteria are added; recalculating and represent the result indicators which indicate the level the search results match the weighted criteria.

As stated in MPEP § 2143, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings, there must be a reasonable expectation of success, and the prior art references must teach or suggest all the claim limitations. See MPEP §2143. The teaching, suggestion, or motivation to combine or modify the teachings of the prior art to produce the claimed invention must be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See, e.g., *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); and MPEP § 2143.01. The teaching or suggestion to make the claimed combination and the reasonable expectation of success may *not* be drawn from the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the *desirability* of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Finally, as stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

In view of the foregoing, Wallman fails to disclose a system or method with the above amendments as recited by independent claims 21 and 28. As such, Wallman fails to disclose or suggest these claims under 35 U.S.C. § 103(a), and withdrawal of the claim rejections is respectfully requested.

DEPENDENT CLAIMS 22, 23, 24, 25, 26, 27, 29, 30, 31, 32, 33 & 34

Claims 22, 23, 24, 25, 26, 27, 29, 30, 31, 32, 33 and 34 all depend from independent claims 21 and 28, and are patentable for at least the same reasons.

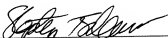
In view of the foregoing, reconsideration and withdrawal of the rejection of claims 22, 23, 24, 25, 26, 27, 29, 30, 31, 32, 33 and 34 are respectfully requested.

CONCLUSION

The Applicants respectfully submit that the current claims are in condition for allowance. Withdrawal of the holding of finality of the Office Action, entry of the following amendments, and reconsideration of the claim rejections are respectfully requested. If the Examiner believes that prosecution might be advanced by discussing the application with Applicants' counsel, in person or by telephone, Applicants' counsel would welcome the opportunity to do so.

This reply is submitted within the 3-month shortened statutory period, and therefore no fees are believed to be due in connection herewith. In the event any fees are required, however, the Commissioner is hereby authorized to charge such fees to the undersigned's deposit account No. 50-0206.

Respectfully submitted,
HUNTON & WILLIAMS

By: 
Stephen T. Schreiner
Registration No. 43,097

Hunton & Williams
1900 K Street, N.W., Suite 1200
Washington, D.C. 20006-1109
Telephone (202) 955-1500
Facsimile (202) 778-2201

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